



Docket No.: V0179.70001US00  
(PATENT)

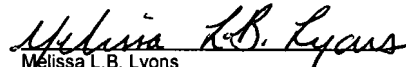
**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: September 11, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES  
Examiner: G. Gabel  
Art Unit: 1641

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 17, 2007

  
Melissa L.B. Lyons

**TRANSMITTAL LETTER**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Renewed Petition To Withdraw Holding Of Abandonment Under 37 CFR §1.181(a)
2. Copy of Dismissed Petition
3. Copy of Paperwork Mailed August 2, 2007 (Petition To Withdraw Holding Of Abandonment Under 37 CFR §1.181(a); Application Data Sheet; Copy of Postcard with OIPE date stamp of May 4, 2007; Copy of Notice of Abandonment; Copy of Mailing from May 1, 2007 including Postcard, Check, Transmittal, Response to Office Action, Petition for 2-Month Extension of Time, and Fee Transmittal)

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 23/2825, under Docket No. V0179.70001US00. A duplicate copy of this paper is enclosed.

Dated: September 17, 2007

Respectfully submitted,

By 

Mary Dilys S. Anderson, Ph.D.

Registration No.: 52,560

WOLF, GREENFIELD & SACKS, P.C.

Federal Reserve Plaza

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

(617) 646-8000

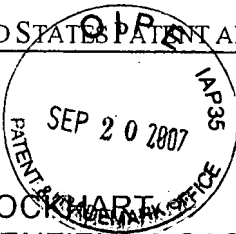


UNITED STATES PATENT AND TRADEMARK OFFICE

**RECEIVED**

Wolf, Greenfield & Sacks, P.C.

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov



SEP 12 2007

HELEN C LOCKHART  
WOLF GREENFIELD & SACKS  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON MA 02210-2211

Docketed ☒ Already Docketed \_\_\_\_\_  
Not Required ☒  
Initials 1st HCL 2nd \_\_\_\_\_

**COPY MAILED**

SEP 10 2007

**OFFICE OF PETITIONS**

ON PETITION

In re Application of  
Erich Wanker et al.  
Application No. 09/485,005  
Filed: September 11, 2000  
Attorney Docket No. V0179/7001

US00

This is a decision on the petition filed August 6, 2007 under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition is DISMISSED.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

The above-referenced application was held abandoned on March 13, 2007, for failure to file a timely response to the non-Final Office Action mailed December 11, 2006, which set a three (3)-month statutory period for reply. Accordingly, a Notice of Abandonment was mailed July 24, 2007.

Petitioner contends that a response to the December 11, 2006 non-Final Office Action was timely filed on May 1, 2007 and points to copies of the response with a certificate of mail dated May 1, 2007 and a postcard receipt date stamped on May 4, 2007 by the USPTO. Unfortunately, neither has been located with the instant petition.

Perhaps the papers were included with the petition and became separated but until such time as sufficient proof of a timely response (including any appropriate extensions of time previously filed) having been filed, the holding of abandonment will not be withdrawn and the notice of abandonment will not be vacated.

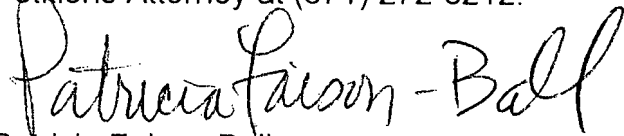
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (571) 273-8300

Telephone inquiries concerning this matter may be directed to the undersigned  
Petitions Attorney at (571) 272-3212.

A handwritten signature in cursive script that reads "Patricia Faison-Ball". The signature is written in dark ink and is positioned above the printed name and title.

Patricia Faison-Ball  
Senior Petitions Attorney  
Office of Petitions



Docket No.: V0179.70001US00  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: September 11, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES  
Examiner: G. Gabel  
Art Unit: 1641

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: September 17, 2007

*Melissa L.B. Lyons*  
Melissa L.B. Lyons

**RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

**UNDER 37 C.F.R. § 1.181(a)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants file this Renewed Petition To Withdraw Holding Of Abandonment Under 37 C.F.R. § 1.181(a) in response to the Dismissed Petition Mailed September 10, 2007.

The Petition to withdraw the holding of abandonment of the above-identified application was dismissed based because the copies of the response with a certificate of mail dated May 1, 2007, and a postcard receipt date stamped on May 4, 2007 by the USPTO were not associated with the file by the USPTO. Applicants have included herewith copies of the response with a certificate of mailing dated May 1, 2007 and the postcard receipt date stamped May 4, 2007 to replace those missing from the file. Applicant hereby files a renewed petition the Commissioner to withdraw the holding of abandonment under 37 CFR § 1.181(a) for the above-identified application for patent. A copy of the Notice of Abandonment and the USPTO decision dismissing the petition are enclosed.

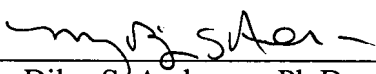
As set forth in the petition under 37 CFR § 1.181(a) to withdraw the holding of abandonment of the above-identified application, an Office Action was received from the USPTO on December 11, 2006. A response to that Office Action was mailed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 1, 2007. The May 1, 2007 response was accompanied by a proper certificate of mailing.

The U.S. Patent and Trademark Office received Applicants' May 1, 2007 communication, as evidenced by the date-stamped return receipt postcard, but the communication appears not to have been entered into the file. Accordingly, the application went abandoned. A copy of the response to the December 11, 2006 Office Action, which was originally mailed to the U.S. Patent and Trademark Office on May 1, 2007, is enclosed herewith. Additionally, enclosed is a copy of the return receipt postcard sent to the U.S. Patent and Trademark Office with the amendment mailed May 1, 2007 and stamped by OIPE on May 4, 2007. Applicants accordingly believe that the papers filed on May 1, 2007 to the U.S. Patent and Trademark Office constituted a timely and complete response to the last pending Office Action.

Applicants do not believe that this petition requires a fee [(see MPEP 711.03(c) (I)], as Applicants timely filed the response, and thus did not abandon this application. Accordingly, no such fee is included. In the event that a fee is due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 23/2825, under Docket No. V0179.70001US00. A duplicate copy of this paper is enclosed.

Dated: September 17, 2007

Respectfully submitted,

By   
MaryDilys S. Anderson, Ph.D.  
Registration No.: 52,560  
WOLF, GREENFIELD & SACKS, P.C.  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
(617) 646-8000



Atty Docket No.: V0179.70001US00

WGS Date: 08/24/07

Inventor: Erich Wanker et al.

Filing Date: September 11, 2000

Application No.: 09/485,005

Title: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR PROTEIN  
AGGREGATES

The USPTO Mail Room acknowledges receipt of the following on the date stamped hereon:

Transmittal Letter

Petition To Withdraw Holding Of Abandonment Under 37 CFR § 1.181(a)

Application Data Sheet

Via: First Class Mail - Certificate of Mailing Under 37 CFR 1.8(a)

Sender's Initials: MXA/mlb

Date Mailed: August 2, 2007



Docket No.: V0179.70001US00  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: September 11, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES  
Examiner: G. Gabel  
Art Unit: 1641

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: August 2, 2007

*Melissa L.B. Lyons*  
Melissa L.B. Lyons

TRANSMITTAL LETTER

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Petition To Withdraw Holding Of Abandonment Under 37 CFR §1.181(a); and
2. Application Data Sheet.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 23/2825, under Docket No. V0179.70001US00. A duplicate copy of this paper is enclosed.

Dated: August 2, 2007

Respectfully submitted,

By *Mary Dilys S. Anderson*  
Mary Dilys S. Anderson, Ph.D.  
Registration No.: 52,560  
WOLF, GREENFIELD & SACKS, P.C.  
Federal Reserve Plaza  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
(617) 646-8000



Docket No.: V0179.70001US00  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: September 11, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES  
Examiner: G. Gabel  
Art Unit: 1641

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: August 2, 2007

*Melissa L.B. Lyons*  
Melissa L.B. Lyons

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

**UNDER 37 C.F.R. § 1.181(a)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The above-identified application became abandoned based on failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. Applicant hereby petitions the Commissioner to withdraw the holding of abandonment under 37 CFR § 1.181(a) for the above-identified application for patent. A copy of the Notice of Abandonment is enclosed.

The last communication received from the U.S. Patent and Trademark Office in this application was mailed on December 11, 2006. A response to that Office Action was mailed to the

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 1, 2007. The May 1, 2007 response was accompanied by a proper certificate of mailing.

The U.S. Patent and Trademark Office received applicant's May 1, 2007 communication, as evidenced by the date-stamped return receipt postcard, but the communication appears not to have been entered into the file. Accordingly, the application went abandoned. A copy of the response to the December 11, 2006 Office Action, which was originally mailed to the U.S. Patent and Trademark Office on May 1, 2007, is enclosed herewith. Additionally, enclosed is a copy of the return receipt postcard sent to the U.S. Patent and Trademark Office with the amendment mailed May 1, 2007 and stamped by OIPE on May 4, 2007. Applicants accordingly believe that the papers filed on May 1, 2007 to the U.S. Patent and Trademark Office constituted a timely and complete response to the last pending Office Action.

Applicants do not believe that this petition requires a fee [(see MPEP 711.03(c) (I)], as Applicants timely filed the response, and thus did not abandon this application. Accordingly, no such fee is included. In the event that a fee is due, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 23/2825, under Docket No. V0179.70001US00. A duplicate copy of this paper is enclosed.

Dated: August 2, 2007

Respectfully submitted,

By 

Mary Dilys S. Anderson, Ph.D.

Registration No.: 52,560

WOLF, GREENFIELD & SACKS, P.C.

Federal Reserve Plaza

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

(617) 646-8000



## **Application Data Sheet**

### **Application Information**

Application Type::	Regular
Subject Matter::	Utility
Suggested Group Art Unit::	1641
CD-ROM or CD-R?::	None
Sequence submission?::	None
Computer Readable Form (CRF)?::	No
Title::	METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR PROTEIN AGGREGATES
Attorney Docket Number::	V0179.70001US00
Request for Early Publication?::	No
Request for Non-Publication?::	No
Small Entity?::	Yes
Petition included?::	No
Secrecy Order in Parent Appl.?::	No

### **Applicant Information**

Applicant Authority Type::	Inventor
Primary Citizenship Country::	Austria
Status::	Full Capacity
Given Name::	Erich
Family Name::	Wanker
City of Residence::	Berlin
Country of Residence::	Germany
Street of mailing address::	Leichhardtstrasse 61
City of mailing address::	Berlin
Country of mailing address::	Germany
Postal or Zip Code of mailing address::	D-14195

Applicant Authority Type::	Inventor
----------------------------	----------

Primary Citizenship Country:: Austria  
Status:: Full Capacity  
Given Name:: Hans  
Family Name:: Lehrach  
City of Residence:: Berlin  
Country of Residence:: Germany  
Street of mailing address:: Terrassenstr 31  
City of mailing address:: Berlin  
Country of mailing address:: Germany  
Postal or Zip Code of mailing address:: D-14129

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: Germany  
Status:: Full Capacity  
Given Name:: Eberhard  
Family Name:: Scherzinger  
City of Residence:: Berlin  
Country of Residence:: Germany  
Street of mailing address:: Lützelsteiner Weg 52  
City of mailing address:: Berlin  
Country of mailing address:: Germany  
Postal or Zip Code of mailing address:: D-14195

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: United Kingdom  
Status:: Full Capacity  
Given Name:: Gillian  
Family Name:: Bates  
City of Residence:: London  
Country of Residence:: United Kingdom  
Street of mailing address:: Flat 2, 8 St. Martin's Close  
City of mailing address:: London

Country of mailing address:: United Kingdom

Postal or Zip Code of mailing address:: NW1 0HR

### Correspondence Information

Correspondence Customer Number:: 23628

Main Phone Number:: (617) 646-8000

Direct Dial Practitioner Phone Number:: (617) 646-8301

Fax Number: (617) 646-8646

Patent Practitioner E-Mail Address:: manderson@wolfgreenfield.com

### Representative Information

Representative Customer Number:: 23628

### Domestic Priority Information

### Foreign Priority Information

Country::	Application Number::	Filing Date:: MM/DD/YY	Priority Claimed::
	PCT/EP98/04810	07/31/1998	Yes
EP	97113320.2	08/01/1997	Yes

### Assignee Information

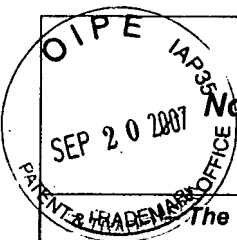
Assignee Name:: MAX-PLANCK-GESELLSCHAFT ZUR  
FÖRDERUNG DER WISSENSCHAFTEN E.V.

Street of Mailing Address::

City of Mailing Address:: Berlin

Country of Mailing Address:: Germany

Postal or Zip Code of Mailing Address::



## Notice of Abandonment

Application No.

09/485,005

Examiner

Gailene R. Gabel

Applicant(s)

WANKER ET AL.

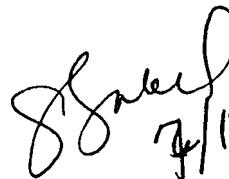
Art Unit

1641

The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 11 December 2006.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

  
7/18/2007

Gailene R. Gabel  
Primary Examiner  
Art Unit: 1641

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



Atty Docket No.: V0179.70001US00

WGS Date: May 11, 2007

Inventor: Erich Wanker et al.

Filing Date: January 31, 2000

Application No.: 09/485,005-Conf. #1379

Title: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR PROTEIN  
AGGREGATES

The USPTO Mail Room acknowledges receipt of the following on the date stamped hereon:

Fee Transmittal (1 page)

Two-Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)

Amendment in Response to Non-Final Office Action (11 pages)

Transmittal Letter (1 page)

Check in the amount of \$225.00



Via: First Class Mail - Certificate of Mailing Under 37 CFR 1.8(a)

Sender's Initials: MXA/sfg

Date Mailed: May 1, 2007

11822R2 1



**Atty Docket No.:** V0179.70001US00

**WGS Date:** May 11, 2007

**Inventor:** Erich Wanker et al.

**Filing Date:** January 31, 2000

**Application No.:** 09/485,005-Conf. #1379

**Title:** METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR PROTEIN  
AGGREGATES

**The USPTO Mail Room acknowledges receipt of the following on the date stamped hereon:**

Fee Transmittal (1 page)

Two-Month Request for Extension of Time Under 37 CFR 1.136(a) (1 page)

Amendment in Response to Non-Final Office Action (11 pages)

Transmittal Letter (1 page)

Check in the amount of \$225.00

**Via:** First Class Mail - Certificate of Mailing Under 37 CFR 1.8(a)

**Sender's Initials:** MXA/sfg

**Date Mailed:** May 1, 2007

1182282 1



DOCKET NO.: V0179.70001US00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

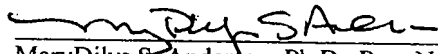
Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: January 31, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES

Examiner: G. Gabel  
Art Unit: 1641

---

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 15<sup>th</sup> day of May, 2007.

  
MaryDilys S. Anderson, Ph.D., Reg. No. : 52,560

---

**MAIL STOP AMENDMENT**

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

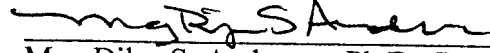
Transmitted herewith are the following documents:

- Response to Office Action (11 pages)
- Petition for 2-Month Extension of Time (1 page)
- Fee Transmittal (1 page)
- Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 646-8000, Boston, Massachusetts.

A check in the amount of \$225.00 is enclosed to cover the filing fee. If the fee is insufficient, the balance may be charged to Deposit Account 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,  
*Erich Wanker et al., Applicants*

By:   
MaryDilys S. Anderson, Ph.D., Reg. No.: 52,560  
Wolf, Greenfield & Sacks, P.C.  
600 Atlantic Avenue  
Boston, Massachusetts 02210-2206  
Telephone: (617) 646-8000

Docket No.: V0179.70001US00  
Date: May 1, 2007  
x5/11/2007x



<b>FEE TRANSMITTAL</b> <b>For FY 2007</b>		<b>Complete if Known</b>	
Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).		Application Number	09/485,005-Conf. #1379
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	January 31, 2000
TOTAL AMOUNT OF PAYMENT (\$)		First Named Inventor	Erich Wanker
225.00		Examiner Name	G. Gabel
		Art Unit	1641
		Attorney Docket No.	V0179.70001US00

**METHOD OF PAYMENT** (check all that apply)

☒ Check    ☐ Credit Card    ☐ Money Order    ☐ None    ☐ Other (please identify): \_\_\_\_\_

☐ Deposit Account    Deposit Account Number: 23/2825    Deposit Account Name: Wolf, Greenfield & Sacks, P.C.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below    ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17    ☒ Credit any overpayments

**FEE CALCULATION**

**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

**Total Claims**    **Extra Claims**    **Fee (\$)**    **Fee Paid (\$)**    **Multiple Dependent Claims**

\_\_\_\_\_ - = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_    **Fee (\$)**    **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

**Indep. Claims**    **Extra Claims**    **Fee (\$)**    **Fee Paid (\$)**

\_\_\_\_\_ - = \_\_\_\_\_ x \_\_\_\_\_ = \_\_\_\_\_

HP = highest number of independent claims paid for, if greater than 3.

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____ / 50 _____ (round up to a whole number) x _____ = _____		

**4. OTHER FEE(S)**

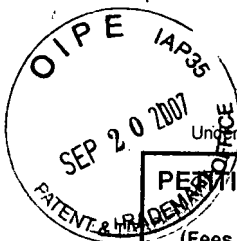
	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): <u>2252 Extension for response within second month</u>	<u>225.00</u>

<b>SUBMITTED BY</b>			
Signature	Registration No. (Attorney/Agent)	52,560	Telephone (617) 646-8000
Name (Print/Type)	MaryDilys S. Anderson, Ph.D.		Date May 1, 2007

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 1, 2007    Signature: MaryDilys S. Anderson (MaryDilys S. Anderson, Ph.D.)



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/22 (09-06)

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

**PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)**

**FY 2006**

(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)

Docket Number (Optional)

V0179.70001US00

Application Number

09/485,005-Conf. #1379

Filed

January 31, 2000

For **METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR PROTEIN AGGREGATES**

Art Unit 1641

Examiner

G. Gabel

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):

	<u>Fee</u>	<u>Small Entity Fee</u>	
<input type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$120	\$60	\$
<input checked="" type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$450	\$225	\$ 225.00
<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$1020	\$510	\$
<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$1590	\$795	\$
<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2160	\$1080	\$

☒ Applicant claims small entity status. See 37 CFR 1.27.

☒ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 23/2825. I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ attorney or agent of record. Registration Number 52,560

☐ attorney or agent under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

MaryDilys S. Anderson  
Signature

May 1, 2007

Date

MaryDilys S. Anderson, Ph.D.

Typed or printed name

(617) 646-8000

Telephone Number

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ Total of 1 forms are submitted.

**Certificate of Mailing Under 37 CFR 1.8(a)**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 1, 2007

Signature: MaryDilys S. Anderson (MaryDilys S. Anderson, Ph.D.)



DOCKET NO.: V0179.70001US00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

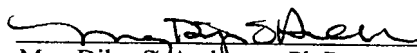
Applicant: Erich Wanker et al.  
Serial No.: 09/485,005  
Confirmation No.: 1379  
Filed: September 11, 2000  
For: METHOD OF DETECTING AMYLOID-LIKE FIBRILS OR  
PROTEIN AGGREGATES

Examiner: Gailene Gabel  
Art Unit: 1641

---

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

The undersigned hereby certifies that this document is being placed in the United States mail with first-class postage attached, addressed to MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the 1st day of May, 2007.

  
MaryDilys S. Anderson, Ph.D.

---

**MAIL STOP AMENDMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT**

Sir:

In response to the Office Action mailed December 11, 2006, please amend the above-identified application as follows:

**Amendments to the Claims** are reflected in the listing of claims that begins on page 2 of this amendment.

**Remarks** begin on page 7 of this amendment.

In the Claims

Please replace all prior versions, and listings, of claims in the application with the following list of claims:

1. (Previously Presented) A method of detecting the presence of detergent- or urea-insoluble amyloid-like fibrils or protein aggregates in a sample on a filter comprising the following steps:
  - (a) contacting a filter with a low capacity for protein adsorption, wherein the filter is cellulose acetate or nitrocellulose, with material of a sample suspected to comprise said amyloid-like fibrils or aggregates which has been previously treated with detergent or urea to solubilize the sample and filtering said sample through the filter to capture said detergent or urea insoluble amyloid-like fibrils or protein aggregates; and
  - (b) detecting whether said amyloid-like fibrils or aggregates are retained on said filter.
2. (Original) The method of claim 1 wherein said amyloid-like fibrils or protein aggregates are indicative of a disease.
3. (Original) The method of claim 2 wherein said disease is a human disease.
4. (Previously Presented) The method of claim 2 wherein said disease is associated with a polyglutamine expansion.
5. (Currently Amended) The method of any one of claims 2 to 3 wherein said disease is Huntington's disease; spinal and bulbar muscular atrophy; dentatorubral pallidoluysian atrophy; spinocerebellar ataxia type-1, -2, -3, -6 or -7; Alzheimer disease; bovine spongiform encephalopathy (BSE); primary systemic amyloidosis; secondary systemic amyloidosis; senile systemic amyloidosis; familial amyloid polyneuropathy I; hereditary cerebral amyloid angiopathy; hemodialysis-related amyloidosis; familial amyloid polyneuropathy III; Finnish hereditary systemic amyloidosis; type II diabetes; medullary carcinoma of the thyroid; spongiform encephalopathies: Kuru, Gerstmann-Sträussler-Scheinker syndrome (GSS), familial

insomnia, and scrapie; atrial amyloidosis; hereditary non-neuropathic systemic amyloidosis; injection-localized amyloidosis; hereditary renal amyloidosis; or Parkinson's disease.

6-7. (Cancelled).

8. (Previously Presented) The method of any one of claims 1 to 3 wherein, prior to step (b), the following step is carried out: (b') washing said filter so as to remove detergent- or urea-soluble material of the sample.

9. (Previously Presented) The method of any one of claims 1 to 3 wherein detergent- or urea-soluble material of the sample is simultaneously with or subsequent to the contacting of said filter with material of the sample in step (a), sucked through said filter.

10. (Previously Presented) The method of any one of claims 1 to 3 wherein detection in step (b) is effected by an antibody, or peptide or polypeptide, preferably a tag or an enzyme, or a fragment or derivative thereof or a chemical reagent that specifically binds to said fibrils or aggregates.

11. (Previously Presented) The method of any one of claims 1 to 3 wherein detection in step (b) is performed by electron microscopy, electron scanning microscopy, fluorescence and/or chemiluminescence.

12. (Previously Presented) The method of claim 1 wherein said material of the sample is derived from tissues or cells of bacteria, yeast, fungi, plants, insects or animals.

13. (Previously Presented) A method of detecting the presence of detergent- or urea-insoluble amyloid-like fibrils or protein aggregates in a sample on a filter comprising the following steps:

(a) contacting a filter with material of a sample suspected to comprise said amyloid-like fibrils or aggregates which has been previously treated with detergent or urea to solubilize the sample and filtering said sample through the filter to capture said

detergent or urea-insoluble amyloid-like fibrils or protein aggregates; and

(b) detecting whether said amyloid-like fibrils or aggregates are retained on said filter wherein said material of the sample comprises a fusion protein comprising a peptide or polypeptide that enhances solubility or prevents aggregation of said fusion protein, an amyloidogenic peptide or polypeptide and a cleavable site that separates the above-mentioned components of the fusion protein, the method further comprising the following steps prior to step (a):

(a') incubating said fusion protein in the presence of a suspected inhibitor of amyloid-like fibril or protein aggregate formation; and

(a'') simultaneously with or after step (a'), further incubating with a compound that induces cleavage at said cleavage site.

14. (Original) The method of claim 13 wherein said cleavable site is an enzymatically cleavable site or a chemically cleavable site or a site cleavable by intein self-cleavage in the presence of thiols.

15. (Previously Presented) The method of claim 13 further comprising, prior to step (b) and after step (a''):

(a''') incubation with an inhibitor of said compound that induces cleavage.

16. (Previously Presented) The method of claim 13 wherein said amyloidogenic peptide or polypeptide comprises a polyglutamine expansion.

17. (Previously Presented) The method of one of claims 4 and 16 wherein said polyglutamine expansion comprises at least 35 glutamines.

18. (Previously Presented) The method of any one of claims 1 and 13 wherein said contacting is effected by dotting, spotting or pipetting said material of the sample onto said filter.

19. (Previously Presented) The method of any one of claims 1 and 13 wherein said filter is a filter membrane.

20. (Previously Presented) The method of any one of claims 1 and 13 wherein said detergent is Sodium Dodecyl Sulphate (SDS) or t-octylphenoxypolyethoxyethanol (TRITON X-100<sup>TM</sup>).

21-26. (Cancelled)

27. (Previously Presented) The method of claim 12 wherein said tissues or cells are from mammals, humans, a transgenic animal or a transgenic plant.

28. (Previously Presented) The method of one of claims 4 and 16 wherein said polyglutamine expansion comprises at least 41 glutamines.

29. (Previously Presented) The method of one of claims 4 and 16 wherein said polyglutamine expansion comprises at least 48 glutamines.

30. (Previously Presented) The method of one of claims 4 and 16 wherein said polyglutamine expansion comprises at least 51 glutamines.

31. (Previously Presented) The method of claim 13, wherein the compound is an enzyme.

32. (Previously Presented) The method of claim 31, wherein the enzyme is a protease.

33. (Previously Presented) The method of claim 13 wherein said amyloid-like fibrils or protein aggregates are indicative of a disease.

34. (Previously Presented) The method of claim 33 wherein said disease is a human disease.

35. (Previously Presented) The method of claim 33 wherein said disease is associated with a polyglutamine expansion.

36. (Currently Amended) The method of claim 33 wherein said disease is Huntington's disease; spinal and bulbar muscular atrophy; dentarorubral pallidoluysian atrophy;

spinocerebellar ataxia type-1, -2, -3, -6 or -7; Alzheimer disease; bovine spongiform encephalopathy (BSE); primary systemic amyloidosis; secondary systemic amyloidosis; senile systemic amyloidosis; familial amyloid polyneuropathy I; hereditary cerebral amyloid angiopathy; hemodialysis-related amyloidosis; familial amyloid polyneuropathy III; Finnish hereditary systemic amyloidosis; type II diabetes; medullary carcinoma of the thyroid; spongiform encephalopathies: Kuru, Gerstmann-Sträussler-Scheinker syndrome (GSS), familial insomnia, and scrapie; atrial amyloidosis; hereditary non-neuropathic systemic amyloidosis; injection-localized amyloidosis; hereditary renal amyloidosis; or Parkinson's disease.

37. (Previously Presented) The method of claim 13 wherein said filter with low protein adsorption is cellulose acetate.

38. (Previously Presented) The method of claim 13 wherein, prior to step (b), the following step is carried out: (b') washing said filter so as to remove detergent- or urea-soluble material of the sample.

39. (Previously Presented) The method of claim 13 wherein detergent- or urea-soluble material of the sample is simultaneously with or subsequent to the contacting of said filter with material of the sample in step (a), sucked through said filter.

40. (Previously Presented) The method of claim 13 wherein detection in step (b) is effected by an antibody, or peptide or polypeptide, preferably a tag or an enzyme, or a fragment or derivative thereof or a chemical reagent that specifically binds to said fibrils or aggregates.

41. (Previously Presented) The method of claim 13 wherein detection in step (b) is performed by electron microscopy, electron scanning microscopy, fluorescence and/or chemiluminescence.

### REMARKS

Applicants respectfully request reconsideration. Claims 1-5, 8-20 and 27-41 were previously pending in this application. Claims 5 and 36 have been amended to replace commas with semicolons to clarify that the spongiform encephalopathies listed in the claim include Kuru, Gerstmann-Sträussler-Scheinker syndrome (GSS), familial insomnia, and scrapie. As a result, claims 1-5, 8-20 and 27-41 are pending for examination with claims 1 and 13 being independent claims. No new matter has been added.

#### Allowable Subject Matter

Claims 13-16 and 31-41 have been allowed.

#### Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1, 10, 12, and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Notario et al., Archivio per le scienze mediche, 135(1):1-8 (1878 Jan-Mar) [Abstract] in view of Mueller (U.S. Patent No. 4,094,775) or Gokcen (U.S. Patent No 6,428,785). Applicants respectfully traverse the rejection.

To support a *prima facie* case for obviousness, the Examiner must demonstrate motivation to combine the teachings in the references to make the claimed invention, a reasonable likelihood of success in making the combination of references, and that the references teach every element of the claimed invention. Applicants submit that these requirements for a *prima facie* case of obviousness have not been met.

Applicants respectfully submit that the modification of Notario in view of Mueller or Gokcen does not result in the instant invention and that the teaching of the references cannot be combined to make the invention as claimed. Notario, the primary reference relied upon by the Examiner, teaches use of cellulose acetate in electrophoretic protein separation. Mueller and Gokcen both describe use of cellulose acetate to filter proteins. The Notario reference teaches a distinct use of a cellulose acetate membrane and a distinct manner of using a cellulose acetate membrane that are both unrelated to the use or manner of using cellulose acetate membranes in the Mueller and Gokcen references.

Applicants submit that the manner of using cellulose acetate membrane for electrophoretic separation as taught in the primary reference, Notario, cannot be modified in light

of the filtration methods of Mueller or Gokcen to make the instant invention, without significant changes in the method of operation of the cellulose acetate membrane method taught in Notario. As stated in the MPEP "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01(VI) citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, the combination of the teaching of Notario with that of Mueller or Gokcen is not a proper basis for the rejection.

Although electrophoresis and filtration can each be performed with a cellulose acetate membrane, the manner in which a membrane is used in electrophoresis and the manner of its use in filtration are very different. In electrophoresis, a sample is applied at one end of a membrane, and due to an applied electric current, protein components of the sample are separated from each other as they migrate longitudinally along the membrane. The electrophoresed sample does not pass through the membrane but remains in the membrane and the sample components are separated along the membrane by the current – resulting in a pattern of proteins along the membrane. The purpose of the electrophoretic separation on the cellulose acetate membrane is to separate individual protein components on the basis of their electrical charge and to permit detection of the resulting longitudinal pattern of separated sample proteins on the membrane. In contrast, in filtration, a sample is applied to a top surface of a membrane and components of the sample that are not retained by the membrane are washed or sucked from the top surface, through the membrane, and out through the bottom surface of the membrane. Unlike the electrophoretic separation method, no electric current is applied and there is no separation of proteins in the sample along the membrane and no resulting longitudinal pattern of separated proteins.

Applicants submit that the use of cellulose acetate as an electrophoretic membrane material as taught by Notario could not be modified by the teaching of Mueller or Gokcen to make the instant filtration-requiring invention without significant changes in the manner in which cellulose acetate membrane of Notario is used. Modification of the teaching of Notario to make the instant invention would change the operation of the cellulose acetate membrane from an electrophoretic surface to a filter that separates urea-soluble from urea-insoluble proteins, which Applicants submit is a significant, and patentably distinct, difference. The necessary modifications would "require a substantial reconstruction and redesign of the elements shown in

[primary reference] as well as a change in the basic principles under which the [primary reference] construction was designed to operate.” *In re Ratti*, at 813, USPQ at 352. Thus, the combination of Notario in view of Mueller or Gokcen does not provide a basis for a *prima facie* case for obviousness.

In addition, the Examiner has not indicated specific motivation for one skilled in the art to combine the electrophoretic methods of Notario with the teaching of Mueller or Gokcen to make the instantly claimed invention. As stated in the MPEP, “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01(VI), citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicants submit that modification of the electrophoretic use of cellulose acetate disclosed in Notario, to a filtration use of cellulose acetate of the instant invention, would make the modified Notario method unsatisfactory for its intended purpose.

Notario’s purpose for using a cellulose acetate membrane electrophoresis is to separate individual proteins of a sample from each other along the membrane – e.g., to generate an electrophoretic pattern of the sample proteins along the membrane, thus allowing identification of the sample proteins based on their migration pattern. Use of a filtration method of the instant invention to separate proteins in a sample separates urea-insoluble from urea-soluble proteins, but does not separate sample proteins from each into a separation pattern along a membrane. The cellulose acetate electrophoretic method of Notario, modified as suggested by the Examiner, would not be suitable for its intended purpose as set forth in the Notario et al abstract. Thus, there is no motivation to combine the references in the manner suggested by the Examiner to modify the teaching of Notario to make the claimed invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 10, 12, and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Notario et al. in view of Mueller or Gokcen.

The Examiner rejected claims 2-5, 8, 9, 11, 17, and 27-30 under 35 U.S.C. §103(a) as being unpatentable over Notario et al., *Archivio per le scienze mediche*, 135(1):1-8 (1878 Jan-Mar) [Abstract] in view of Mueller (U.S. Patent No. 4,094,775) or Gokcen (U.S. Patent No 6,428,785), as applied to claims 1, 10, 12, and 18-20 above, and in further view of Kalchman et al. (WO 97/18825). Applicants respectfully traverse the rejection.

Applicants submit that the modification of Notario in view of Mueller or Gokcen in further view of Kalchman does not result in the instant invention and that the teaching of the references cannot be combined to make the invention as claimed. As described above, the technology of Notario includes the use of cellulose acetate in electrophoretic separation methods and the technologies in Mueller and Gokcen include the use of cellulose acetate as filters. The technology disclosed in Kalchman relates to the separation of HIP1 and huntingtin proteins by electrophoresis followed by blotting of proteins onto PVDF membranes. Applicants submit that the manner of using cellulose acetate membrane for electrophoretic separation as taught in the primary reference, Notario, cannot be modified in light of the filtration methods of Mueller or Gokcen, in further view of the blotting methods of Kalchman to make the instant invention, without significant changes in the method of operation of the cellulose acetate membrane method taught in Notario. As stated in the MPEP, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP 2143.01(VI) citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, the combination of the teaching of Notario with that of Mueller or Gokcen, in further view of Kalchman is not a proper basis for an obviousness rejection.

Applicants submit that methods of using cellulose acetate as an electrophoretic membrane material as taught by Notario could not be modified by the teaching of Mueller or Gokcen in view of Kalchman to make the instant filtration-requiring invention without significant changes in the manner in which cellulose acetate membrane of Notario is used. The necessary modifications would "change the principle of operation of the prior invention being modified." *Id.* Thus, the combination of Notario in view of Mueller or Gokcen does not provide a basis for a *prima facie* case for obviousness.

In addition, the Examiner has not indicted specific motivation for one to combine the electrophoretic methods of Notario with the teaching of Mueller or Gokcen, in further view of Kalchman, to make the instantly claimed invention. As stated in the MPEP, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP 2143.01(VI), citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As described above, Applicants submit that modification of the electrophoretic use of cellulose acetate in

Notario, to a filtration use of cellulose acetate, would make the modified method unsatisfactory for its intended purpose. Notario's purpose for using a cellulose acetate membranes is to electrophoretically separate individual proteins of a sample from each other along the membrane – e.g., to generate an electrophoretic pattern of the sample proteins along the membrane. Use of a filtration method of the instant invention to separate proteins in a sample separates urea-insoluble from urea-soluble proteins, but does not separate sample proteins from each other into a separation pattern along a membrane. Thus, the cellulose acetate electrophoretic method of Notario, modified as suggested by the Examiner, would not be suitable for its intended purpose as set forth in the Notario et al abstract. Thus, there is no motivation to combine the references in the manner suggested and to modify the teaching of Notario to make the claimed invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-5, 8, 9, 11, 17, and 27-30 under 35 U.S.C. §103(a) as being unpatentable over Notario et al., Archivio per le scienze mediche, 135(1):1-8 (1878 Jan-Mar) [Abstract] in view of Mueller (U.S. Patent No. 4,094,775) or Gokcen (U.S. Patent No 6,428,785), as applied to claims 1, 10, 12, and 18-20 above, and in further view of Kalchman et al. (WO 97/18825).

### CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,  
*Erich Wanker et al., Applicant(s)*

By:



MaryDilys S. Anderson, Ph.D.

Reg. No. 52,560

Wolf, Greenfield & Sacks, P.C.

600 Atlantic Avenue

Boston, Massachusetts 02210-2206

Telephone: (617) 646-8000

Docket No.: V0179.70001US00  
Date: May 1, 2007  
x05/11/07x